

REMARKS

This patent application presently includes claims 1, 3-14, 26 and 29-35, of which claims 12, 26, 29 and 30 have been withdrawn from consideration as based upon a non-elected species, claim 10 has been objected to as based on a rejected claim, but indicated as allowable if rewritten an independent form, and claims 1, 3-9, 11, 13, 14 and 31-34 stand rejected. Claims 9 and 10 have been amended only for clarity and to broaden the claims slightly. Claim 10 has been rewritten in independent form as claims 10 and 35.

Claims 12, 26, 29 and 30 were withdrawn from further consideration pursuant to 37 C.F.R. § 1.142(b) as drawn to a non-elected species. Claim 12 is dependent from claim 1 and claim 26 has been amended to dependent from claim 31. As will be demonstrated below, claims 1 and 31 are allowable accordingly, claims 12 and 26 depend from an allowable claim which is generic thereto. Accordingly, claims 12 and 26 should also be allowed at this time.

Claims 1, 3 and 31 were rejected as obvious over either JP2001-78874 or Kelleghan in view of Henderson, et al. and Ayon, et al. These rejections are respectfully traversed. None of these references, or any combination thereof renders these claims obvious.

Initially, the undersigned feels compelled to object to the Examiner's entire approach to making the obviousness rejections in the present instance. In the Office Action, the Examiner has improperly, selectively combined disclosures from multiple references to make the present rejections. To say the least, these are improbable combinations. Basically, the examiner has used the disclosure of the present application to arbitrarily select features from the cited references to make the rejection. Apparently, the examiner has overlooked the requirement that for references to be combined, "there must be some reason, suggestion or motivation found in the prior art whereby a person of ordinary skill in the field of the invention would make the combination. That knowledge cannot come from the applicants' invention itself." *In Re Oetiker*, 24 U.S.P.Q. 2d 1443 (Fed. Cir. 1992). "The mere fact that the prior art may be modified in the manner suggested by the examiner does not make the modification obvious unless the prior art suggested the desirability of the modification." *In re Fritch*, 23 U.S.P.Q. 2nd 1780, 1783 (Fed Cir. 1992).

It is error to reconstruct the patentee's claimed invention from prior art by using the patentee's claim as a "blueprint" when prior art references require selective combination to render obvious a subsequent invention. There must be some reason for the combination other than the hindsight obtained

from the invention itself. *Interconnect Planning Corp. v. Feil*, 774 F.2d 1132 (Fed. Cir. 1985).

Indeed, the only disclosure for the combinations made by the examiner (which, nevertheless, do not lead to the present invention) is the present patent application itself. As stated by the CAFC in *In Re Fritch*, 23 USPQ 2d. 1780 (Fed. Cir. 1992):

[I]t is impermissible to use the claimed invention as an instruction manual or "template" to piece together the teachings of the prior art so that the claimed invention is rendered obvious... This court has previously stated that "one cannot use hindsight reconstruction to pick and choose among isolated disclosures in the prior art to deprecate the claimed invention."

The CAFC has also stated that:

As in all determination under 35 U.S.C. §103, the decision maker must bring judgment to bear. It is impermissible, however, simply to engage in a hindsight reconstruction of the claimed invention, using the applicant's structure as a template and selecting elements from references to fill the gaps.

In Re Gorman, 18 USPQ 2d. 1885 (Fed. Cir. 1991).

It might very well be asked how the present invention could be considered obvious, since, as explained above, there are substantial benefits derived from the invention and none of the references even suggests it.

We do not pick or choose among the individual elements of assorted prior art references to recreate the claimed invention, but rather, we look for some teaching or suggestion in the references to

support their use in the particular claimed combination.

Symbol Technologies, Inc. v. Opticon, Inc., 19 USPQ 2d. 1241 (Fed. Cir. 1991). It is by now well settled that obviousness cannot be established by combining the teachings of prior art references to produce a claimed invention, absent some teaching or suggestion supporting the combination. *ACS Hospital Systems, Inc. v. Montifore Hospital*, 221 USPQ 929 (Fed. Cir. 1984).

In summary, the examiner has no basis for making the combination he suggests, and even if that combination were made, it would not lead to the present invention.

The Japanese reference could hardly be considered a novelty figurine. In fact, it discloses an action character which is hung in a noose-like fashion from a keychain containing a carabiner. The keychain could hardly be considered as extending from the body portion, since the noose is placed about the characters neck. Kelleghan discloses a carabiner in which a dolphin shape is formed on the carabiner ring. Similarly to the Japanese reference, Henderson discloses an item at the end of a keychain ring. In this case, there is an enclosure with a book inside. Ayon discloses an insulated container which has the appearance of a puppet. There is not the slightest suggestion of a carabiner or any other connector. It is hardly seen how those skilled in the art would even consider combining these references in the absence of the disclosure of a

present patent application. Even then, they would not arrive at the claimed subject matter.

In accordance with claim 1, the carabiner attachment includes a leg which is firmly secured to the body and extends rearwardly behind the head. The head and leg are proportioned so that the leg is hidden by the head when viewed from the front. None of the references teach or suggest this structure. Moreover, the structure results in a particularly unique device. For example, as shown in FIG. 1, when the figurine is viewed from the front, the carabiner is not visible and it appears simply as a figurine. At the same time, since the leg is firmly secured to the body, it may be used as a gripping handle to manipulate the figurine and to hold it in a fixed position while the door is opened, so as to avoid the possibility of spilling the contents. Neither the Japanese reference, Kelleghan or Henderson have this feature or the related ability. In Ayon, the handle is clearly visible above the device as viewed from the front, ruining its appearance as a figurine. Accordingly, claim 1 is believed to be allowable.

Claim 3 depends from claim 1 and is allowable based upon its dependence from an allowable claim.

Claim 31 has some of the same limitations as claim 1, including the carabiner being firmly affixed to the body, extending rearwardly therefrom, and being concealed by the head when viewed

from the front. Accordingly, claim 31 is believed to be allowable for the same reasons as claim 1.

Claims 4-9 and 11 were rejected as obvious on the same basis as claim 1, further in view of JP10-118340. This rejection is respectfully traversed. None of these references nor any combination thereof renders these claims obvious.

The Examiner cited JP10-118340 for the alleged disclosure that the figurine could be modified so as to stand and so as to provide a hinged door. However, JP10-118340 does not cure any of the shortcomings of the other references or their combination as an appropriate basis for an obviousness rejection. Accordingly, this last named reference would not effect the allowability of claim 1 as explained above. Claims 4-9 and 11 depend from claim 1 and are allowable based upon the allowability of claim 1.

Claims 13 and 14 were rejected as obvious on the same basis as claim 1, further in view of Forrest. This rejection is respectfully traversed. None of these references nor any combination thereof renders a present claim as obvious.

The Examiner cited Forrest to demonstrate the modification of the other references to include a carabiner with a pivoted gate or resilient gate. However, Forrest does not cure the shortcomings of the other references, or their combination as a proper basis for the rejection of claim 1. Accordingly, it would not affect the

allowability of claim 1. Claims 13 and 14 depend from claim 1 and are allowable based upon their dependence from an allowable claim.

Claims 32 and 33 were rejected as obvious over JP2001-78874 in view of Abbondandolo and claim 34 was rejected on the same basis further in view of Millard. These rejections are respectfully traversed. None of these references nor any combination thereof renders a present claim as obvious.

In accordance with claim 32, the figurine includes means to support it in a substantially upright standing position with the head portion located substantially above the body portion. Neither of these references includes such means *on the figurine*. According to the Japanese reference, the figurine is merely hung from its noose, and according to Abbondandolo, the figurine is secured to another surface which supports it. Accordingly, those references require that some other object support the figurine in an upright position. Therefore, both references, in fact, teach away from, having means on the figurine to support it in an upright, standing position. Claim 32 is therefore believed to be allowable. Claim 34 depends from claim 32 and is allowable based upon its dependence from an allowable claim.

The Examiner indicated that claim 10 would be allowable if we written an independent form. Claim 10 has been so rewritten as claim 10/7 and claim 35 corresponds to claim 10/8, accordingly, are believed to be in condition for allowance.

Applicant's attorney has made every effort to place this patent application in condition for allowance. It is therefore honestly requested that this application, as a whole, receive favorable reconsideration and that all of the claims be allowed as presently constituted. Should there remain any unanswered questions, the Examiner is requested to call the Applicant's undersigned attorney at the telephone number indicated below.

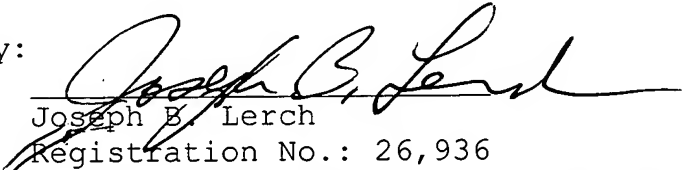
Applicant has included a Petition for a One-Month Extension of Time with this response, along with the appropriate fee.

Applicant does not believe any fees are due with this Amendment. However, in the event there are any fees due and owing in connection with this matter, please charge same to our Deposit Account No. 11-0223.

Dated: May 3, 2006

Respectfully submitted,

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